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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,078	09/11/2000	Cary Lee Bates	ROC920000078US1	4594
24033	7590	10/14/2004	EXAMINER	
KONRAD RAYNES & VICTOR, LLP 315 S. BEVERLY DRIVE # 210 BEVERLY HILLS, CA 90212			HILLERY, NATHAN	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/658,078	Applicant(s) BATES ET AL.	
	Examiner Nathan Hillery	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 15-25 and 29-39 is/are pending in the application.
- 4a) Of the above claim(s) 12-14, 26-28 and 40-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15-25 and 29-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 6/14/04.
2. Claims 1 – 11, 15 – 25, and 29 – 39 are pending in the case. Claims 1, 15, and 29 are independent. Claims 12 – 14, 26 – 28, and 40 – 42 have not be elected for examination at this time.
3. The objection to the Specification has been withdrawn as necessitated by amendment.
4. The rejection of claims 1 – 11, 15 – 25, and 29 – 39 under 35 U.S.C. 103(a) as being unpatentable has been maintained.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 – 11, 15 – 25, and 29 – 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Courter et al. (Microsoft Office 2000).
7. **Regarding independent claim 1**, Courter et al. teach that *to enter an e-mail address, enter the entire address, including the username and the domain name. When you move out of the text box, Outlook analyzes the address you entered to ensure that it resembles a valid e-mail address looking for a username, the @ symbol, and a domain name. If Outlook doesn't find what it's looking for, it opens the Check Names dialog box, shown in figure 18.5 (page 407, second block paragraph), which provide for*

scanning and parsing words in the text; for each set of one or more scanned and parsed words, determining whether one or more words form a contact phrase providing information to identify or address a person or entity; after scanning one contact phrase ... accessing contact information including contact phrases, and searching the contact information to determine if the scanned contact phrase matches contact phrases in the searched contact information. Courter et al. do not explicitly teach **checking text in an electronic document**; however, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to do so since the invention of Courter et al. searches the header of an e-mail message to ensure that the user is sending the message to the desired recipient(s).

8. **Regarding dependent claim 2**, Courter et al. teach *using Outlook contact forms to collect and manage information about business and personal contacts* (page 403, caption under Figure 18.1). Further, Courter et al. illustrate a contact form in Figure 18.1, which provides that the **contact phrases comprise one of a name, phone number, street address, e-mail address, and URL.**

9. **Regarding dependent claim 3**, the claim incorporates substantially similar subject matter as claims 4 – 5, and is rejected along the same rationale.

10. **Regarding dependent claims 4 – 5**, Courter et al. teach that *Outlook uses the Check Names dialog box to clarify an incomplete or erroneous e-mail address* (page 407, caption under Figure 18.5). Further, Courter et al. illustrate a dialog box in Figure 18.5, which provide for **displaying a graphical box for one scanned contact phrase that does not match contact phrases in the contact information, wherein the user**

is capable of using the displayed graphical box to accept the scanned contact phrase or select another contact phrase to substitute for the scanned contact phrase; determining at least one contact phrase, in the contact information that is similar, but not identical, to the scanned contact phrase if the scanned contact phrase does not match one contact phrase in the contact information; and displaying the determined contact phrases in the displayed graphical box, wherein the user is capable of using the displayed graphical box to select one displayed contact phrase to substitute for the scanned contact phrase.

11. Regarding dependent claim 6, Courter et al. teach that *an address book is a list of names you can select addresses from. You may have only one address book* (page 444, bottom) and that *the Outlook Address Book automatically contains the entries in your Contacts folder ...* (page 444, last paragraph), which provide that **the contact information comprises contact records for different contacts in a computer readable address book, wherein each contact record is capable of including multiple different contact phrases for one contact.**

12. Regarding dependent claim 7, Courter et al. do not explicitly teach **determining whether the scanned URL, contact phrase addresses an accessible page on the Internet; and presenting information indicating whether the scanned URL addresses an accessible page on the Internet.** However, it would have been obvious to one of ordinary skill in the art at the time of the invention to know that since Courter et al. teach that *by adding a hyperlink pointing to the site to the General page of the Contact form, you can access the contact's Web site with one quick click of the*

mouse (page 408, first block) then the user's web browser will launch and attempt to retrieve the link that was clicked. The user's web browser will then present the page or report an error thus indicating if the URL is accessible over the Internet or not.

13. **Regarding dependent claim 8**, Courter et al. teach that *there are three ways to enter e-mail addresses ... by searching for the person's e-mail address with a directory service* (page 443, last paragraph) and that *the directory could be ... on a public directory service you access via the Internet, such as Four11 or Bigfoot. You use directory services when you know a person's name, but don't have their e-mail address* (page 446, third block paragraph), which provide that **the scanned contact phrase comprises a name or contact address; for submitting a search request over the Internet to an Internet directory for the scanned contact phrase; and for receiving information indicating that there is no match for the scanned contact phrase in the Internet directory or that there is a match.**

14. **Regarding dependent claim 9**, Courter et al. teach that *Outlook uses the Check Names dialog box to clarify an incomplete or erroneous e-mail address* (page 407, caption under Figure 18.5). Further, Courter et al. illustrate a dialog box in Figure 18.5, which provide for **adding the scanned contact phrase to the contact information if the scanned contact phrase does not match one contact phrase in the contact information.**

15. **Regarding dependent claim 10**, Courter et al. do not explicitly teach **buffering**. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to do so since the invention of Courter et al. has the ability to

store up to 19 different telephone numbers for a contact (page 406, last line of second block) formatted similarly; thus, the skilled artisan would be able to save resources and memory. Further, Courter et al. do teach to *just enter the digits in the telephone number ... when you move out of the text box, Outlook will automatically format the digits, adding parentheses, spaces, and hyphens. If you enter a seven-digit telephone number, Outlook assumes the phone number is local, and adds your area code to the number* (page 406, third and fourth blocks), which provides for **buffering contact phrases of a same type of contact information; determining whether the buffered contact phrases of the same type use consistent syntax; and notifying a user of inconsistencies in the syntax for the buffered contact phrases.**

16. **Regarding dependent claim 11**, Courter et al. teach that *when you enter a world Wide Web URL in the Web Page Address text box, enter the resource name ... and when you leave the text box, Outlook will automatically add http:// to the beginning of the URL* (page 407, last block), which provides that **the scanned contact phrases include at least one URL address; determining whether each scanned URL contact phrase uses a correct URL syntax; and notifying the user of incorrect syntax for at least one of the scanned URL contact phrases.**

17. **Regarding independent claim 15**, the claim incorporates substantially similar subject matter as claim 1, and is rejected under the same rationale.

18. **Regarding independent claim 16**, the claim incorporates substantially similar subject matter as claim 2, and is rejected under the same rationale.

19. **Regarding independent claim 17**, the claim incorporates substantially similar subject matter as claim 3, and is rejected under the same rationale.
20. **Regarding independent claim 18**, the claim incorporates substantially similar subject matter as claim 4, and is rejected under the same rationale.
21. **Regarding independent claim 19**, the claim incorporates substantially similar subject matter as claim 5, and is rejected under the same rationale.
22. **Regarding independent claim 20**, the claim incorporates substantially similar subject matter as claim 6, and is rejected under the same rationale.
23. **Regarding independent claim 21**, the claim incorporates substantially similar subject matter as claim 7, and is rejected under the same rationale.
24. **Regarding independent claim 22**, the claim incorporates substantially similar subject matter as claim 8, and is rejected under the same rationale.
25. **Regarding independent claim 23**, the claim incorporates substantially similar subject matter as claim 9, and is rejected under the same rationale.
26. **Regarding independent claim 24**, the claim incorporates substantially similar subject matter as claim 10, and is rejected under the same rationale.
27. **Regarding independent claim 25**, the claim incorporates substantially similar subject matter as claim 11, and is rejected under the same rationale.
28. **Regarding independent claim 29**, the claim incorporates substantially similar subject matter as claim 1, and is rejected under the same rationale.
29. **Regarding independent claim 30**, the claim incorporates substantially similar subject matter as claim 2, and is rejected under the same rationale.

30. **Regarding independent claim 31**, the claim incorporates substantially similar subject matter as claim 3, and is rejected under the same rationale.
31. **Regarding independent claim 32**, the claim incorporates substantially similar subject matter as claim 4, and is rejected under the same rationale.
32. **Regarding independent claim 33**, the claim incorporates substantially similar subject matter as claim 5, and is rejected under the same rationale.
33. **Regarding independent claim 34**, the claim incorporates substantially similar subject matter as claim 6, and is rejected under the same rationale.
34. **Regarding independent claim 35**, the claim incorporates substantially similar subject matter as claim 7, and is rejected under the same rationale.
35. **Regarding independent claim 36**, the claim incorporates substantially similar subject matter as claim 8, and is rejected under the same rationale.
36. **Regarding independent claim 37**, the claim incorporates substantially similar subject matter as claim 9, and is rejected under the same rationale.
37. **Regarding independent claim 38**, the claim incorporates substantially similar subject matter as claim 10, and is rejected under the same rationale.
38. **Regarding independent claim 39**, the claim incorporates substantially similar subject matter as claim 11, and is rejected under the same rationale.

Response to Arguments

39. Applicant's arguments filed 6/14/04 have been fully considered but they are not persuasive.

40. In response to Applicant's argument that Courter et al. does not teach all of the limitations of claim 1 (p.16, last paragraph), it should be noted that Outlook analyzes the text on the fly. The user initiates input in the text field, and Outlook, then, parses the input and determines if the input is a valid contact phrase (i.e., e-mail address). If Outlook determines that the input is an invalid or unrecognizable contact phrase (i.e., e-mail address), then Outlook offers suggestions (i.e., list of validated contact phrases) as depicted in Fig 18.5 of Courter et al. on page 407 via the Check Names dialog box.

Conclusion

41. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (703) 305-4502. The examiner can normally be reached on M - F, 6:30 a.m. - 3:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER

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